

RECEIVED
CENTRAL FAX CENTER

JAN 05 2007

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 15 and 16 are allowable and that claims 6, 7, 11 and 12 contain allowable subject matter.

In the Official Action, the Examiner rejects claims 1-5 and 8-10 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,071,279 to Whayne et al., (hereinafter "Whayne"). Additionally, the Examiner rejects claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Whayne in view of U.S. Patent No. 4,927,418 to Dake et al., (hereinafter "Dake").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(a) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features.

Specifically, claim 1 has been amended to clarify that the retaining wire extends parallel to the guide wire body along a length between the distal end portion of the guide wire body and the proximal end portion of the guide wire body. The amendment to claim 1 is fully disclosed in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claim 1.

In Whayne, the wire 106 is not arranged in parallel with the sleeve 32 body over a length between the distal end portion and the proximal end portion of the sleeve 32. In other words, the wire 106 and the distal end of the sleeve 32 is connected in the direction opposite to that of the connection between the retainer and the guide wire body recited in claim 1. Therefore, even if the sleeve 32 is retracted into the sheath 102, the loop of the wire 106 remains (see especially FIG. 15).

Contrary to the guide wire recited in claim 1, Wayne intends to form a loop by the sleeve 32, to which the wire 106 is connected. Therefore, Wayne does not teach or suggest arranging the wire 106 in parallel with the sleeve 32 body over a length between the distal end portion and the proximal end portion of the sleeve 32.

With regard to the rejection of claims 1-5 and 8-10 under 35 U.S.C. § 102(a), a guide wire and endoscope having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Wayne. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by Wayne. Accordingly, independent claim 1 patentably distinguishes over Wayne and is allowable. Claims 2-5 and 8-10 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-5 and 8-10 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 13 and 14 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 13 and 14 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 13 and 14 under 35 U.S.C. § 103(a).

Furthermore, new claims 54 and 55 have been added to further define the patentable invention. New claims 54 and 55 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 54 and 55.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

New claims 54 and 55 recite that the retainer is arranged outside the appliance. Applicants respectfully submit that the structure recited in the new claims differs from Whayne at least in this respect. In Whayne, when the wire 106 is inserted in a lumen of the appliance, the retainer 100 is inserted in another lumen of the appliance (see FIG. 17B). Thus, Applicants submit that independent claims 54 and 55 patentably distinguish over the prior art and are allowable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm/dg